

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Patent Application of: Robert L. Barrett et al

Group Art Unit: 3623 : IBM Corporation  
Examiner: Romain Jeanty : Intellectual Property Law  
Serial No.: 09/882,148 : Department SHCB/040-3  
Filed: 06/15/2001 : 1701 North Street  
Title: BUSINESS ENGAGEMENT : Endicott, New York 13760  
METHOD

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Dear Sir:

Appellants hereby appeal from the Final Action of  
10/25/2006 and offer the following arguments in support thereof:

**(i) REAL PARTY IN INTEREST**

The real party in interest is International Business  
Machines Corporation, a corporation of New York, with a place of  
business at Armonk, NY 10504.

**(ii) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences with which  
the undersigned is aware.

**(iii) STATUS OF CLAIMS**

Claims 1 - 13 are pending in the present application. Claims 1 - 13 have all been finally rejected and are the subject matter of this appeal.

**(iv) STATUS OF AMENDMENTS**

There were no amendments filed subsequent to the final rejection of 10/25/2006.

**(v) SUMMARY OF CLAIMED SUBJECT MATTER**

Appellants' invention relates to a unique method and computer program product for delivering an integrated information technology system solution to a client. The method is related to patent application 09/625,108 filed 07/25/00 (now issued patent 6,950,802 issued 09/27/05, herein referred to as Barnes) having the same assignee as the present application. The method claimed, however, is an improvement over Barnes, is inventably distinct, and provides certain operational advantages over Barnes when applied to multiple clients.

According to Appellants' independent claim 1, a method of business engagement is performed by the following steps: (refer to FIG. 15 and Appellants' Specification page 53, line 13, to page 55, line 11). An engagement model 502, which will be used to address a marketplace requirement, is defined. Subject matter experts 504 and best practices 508 may be involved in defining engagement model 502. However, claim 1 itself does not

require their involvement. Various other methods for defining an engagement model are found in Appellants' Specification on page 15, line 4, to page 16, line 18, and more specifically page 25, lines 16 - 21. Also see FIGs. 1 and 4.

Claim 1 further requires that this engagement model be used to create an industry-wide engagement template 506 applicable to all businesses in the marketplace. The marketplace is the one that has the requirements that the engagement model was defined to address.

Claim 1 then requires that this industry-wide engagement template be modified 510 to address the requirements 514 of a specific client within this marketplace.

Finally, claim 1 requires that thereafter a client engagement be measured, monitored, and controlled 516 based on this modified industry-wide engagement template 510.

According to Appellants' independent claim 8, a computer program product is provided to assist in performing identical steps to those just described above for claim 1. References to the Specification, drawings, and reference characters are identical and are therefore not specifically stated here to avoid repetition.

**(vi) GROUND OF REJECTION**

There is only one ground of rejection. Claims 1 - 13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over

Young (U.S. Patent 6,915,270) in view of Barnes (U.S. Patent 6,950,802).

Specifically, regarding the four clauses of claim 1, the Examiner states that Young discloses the first two clauses, but admits Young does not disclose the last two clauses. The Examiner states that the third (modifying) clause is old and well-known and that Barnes discloses the final clause of claim 1. Appellants respectfully disagree as argued below.

Independent claim 8 is rejected by the Examiner under the same rationale relied upon of claim 1.

There are no other independent claims.

Appellants do not argue separately patentability of any of the dependent claims.

**(vii) ARGUMENT**

Claim 1 - 13 are patentable under 35 U.S.C. 103(a) over the prior art and particularly, U.S. Patents 6,915,270 (Young) in combination with 6,950,802 (Barnes).

The combination of Barnes with Young does not describe or suggest all of the required steps of Appellants' claim 1.

Appellants' claim 1 requires defining an engagement model. According to Appellants' Specification page 53, lines 15 - 17, the engagement model 502 of FIG. 15 is developed in a similar

manner to engagement model 106 of FIG. 1. Page 10, lines 17 - 19, states that engagement model 106 describes a system and method for implementing a typical project. The engagement model of claim 1 is similar to the engagement model of Barnes to which the present invention is related as specified on page 1, lines 5 - 8.

However, claim 1 thereafter in the second clause departs from Barnes by requiring that this engagement model be used to create an industry-wide engagement template applicable to all businesses in the marketplace (the marketplace being the marketplace which the engagement model addresses). See also Appellants' Specification page 53, line 22, to page 54, line 9, which describes how subject matter experts 504 of FIG. 15 create this industry-wide template 506 for a specific industry, such as procurement, manufacturing, or banking, by extracting out from engagement model 502. Because the industry-wide engagement template 506 applies to any client in the specific industry, it may be re-used multiple times—an important advantage over Barnes.

Barnes does not describe or suggest creating such an industry-wide engagement template using the engagement model. According to Barnes' column 3, lines 49 - 52, his engagement template 108 describes the system and method for an actual project. There is no suggestion that this actual project is in any way industry-wide or applicable to all businesses in the marketplace.

The Examiner admits on page 5, line 4, of his Final

Rejection dated 10/25/2006 that Barnes does not disclose creating an industry-wide engagement template at all and therefore certainly not one created by using the engagement model of the first clause of Appellants' claim 1. However, the Examiner states that it is old and well known in the art to create an industry-wide engagement template, but does not provide any evidence that this is so. The Examiner further directs Appellants (at line 10, page 5, of the Final Rejection dated 10/25/2006) to the Dialog Practicality document. Note - this document was not cited in the 103(a) rejection. This document describes templates on page 4, last paragraph. However, there is nothing described or suggested that these are engagement templates, industry-wide engagement templates, and whether they are created using an engagement model, as required by Appellants' claim 1.

Appellants argue, therefore, that the complete lack of any suggestion of an industry-wide engagement template in either Barnes, which was filed less than one year before Appellants' present application, or in the Dialog Practicality document dated less than one year before Appellants' filing date suggests that such industry-wide engagement templates and in particular industry-wide engagement templates created using an engagement model were not old and well known at the time of Appellants filing.

Appellants maintain the Examiner has erred in stating that such is "old and well known" without providing any evidence to support the statement.

In an earlier rejection dated 05/03/2006, the Examiner stated that Young disclosed this required step of creating an industry-wide engagement template using the engagement model. Appellants were successful in rebutting this citation and the Examiner removed it in the Final Rejection. It is clear that Young does not describe this important step of claim 1 either. Nor is there any way suggested to combine Young and Barnes in order to describe this step. Rejection of claim 1 under 35 U.S.C. 103(a) therefore is in error.

Rejection of independent claim 8 is also in error for the same reasons.

In view of the above, Appellants respectfully request that the Board reverse the Examiner's Final Rejection of all of the claims on appeal, and allow these claims.

Respectfully submitted,

Dated: 02/17/07

By: /John Pivnichny/

John R. Pivnichny

Reg. No. 43,001

Telephone: (607)429-4358

Fax: (607)429-4119

**(viii) CLAIMS APPENDIX**

1. (Original) A method of business engagement, comprising the steps of:

defining an engagement model which will be used to address a marketplace requirement;

thereafter using said engagement model to create an industry-wide engagement template applicable to all businesses in said marketplace;

modifying said industry-wide engagement template to address requirements of a specific client within said marketplace; and

thereafter measuring, monitoring, and controlling a client engagement based upon said modified industry-wide engagement template.

2. (Original) The method of claim 1, further comprising the steps of enabling a generic engagement model for addressing said marketplace requirement, and generating work product descriptions specified by said engagement model.

3. (Original) The method of claim 1, further comprising using said engagement model to create a plurality of industry-wide engagement templates each said template applicable to all



businesses in each of a respective plurality of industries in said marketplace.

4. (Original) The method of claim 2, wherein said generic engagement model includes definitions of best practices and reusable assets.

5. (Original) The method of claim 1, further including the step of creating attack, resource, and deployment plans for said client engagement using said modified industry-wide engagement template.

6. (Original) The method of claim 2, further including the step of cyclically redefining said modified industry-wide engagement template while deploying said work product descriptions.

7. (Original) The method of claim 1, further including the step of allocating resources to further attack said marketplace requirement based upon said monitoring.

8. (Original) A computer program product for instructing a processor to assist in performing a business engagement process, said computer program product comprising:

a computer readable medium;

first program instruction means for defining an engagement model which will be used to address a marketplace requirement;

second program instruction means for thereafter using said engagement model to create an industry-wide engagement template applicable to all businesses in said marketplace;

third program instruction means for modifying said industry-wide engagement template to address requirements of a specific client within said marketplace; and

fourth program instruction means for thereafter measuring, monitoring, and controlling a client engagement based upon said modified industry-wide engagement template; and wherein

all said program instruction means are recorded on said medium.

9. (Original) The computer program product of claim 8, wherein one or more of said program instruction means are adapted to permit entry or exit from said respective program instruction means.

10. (New) The method of claim 1, wherein said engagement model is made up of a process description and is implemented as a work breakdown structure made of phases, activities, tasks, work product descriptions, techniques, and roles.

11. (New) The method of claim 10, wherein said engagement model defines what gets produced over the lifetime of said business engagement, roles required to perform said business engagement, and techniques to be used.

12. (New) The computer program product of claim 8, wherein said engagement model is made up of a process description and is implemented as a work breakdown structure made of phases, activities, tasks, work product descriptions, techniques, and roles.

13. (New) The computer program product of claim 12, wherein said engagement model defines what gets produced over the lifetime of said business engagement, roles required to perform said business engagement, and techniques to be used.

(ix) EVIDENCE APPENDIX

None.

(x) RELATED PROCEEDINGS APPENDIX

None.